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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,479	08/23/2001	Yoko Fujiwara	018656-241	8426
7590 Platon N. Mandros BURNS, DOANE, SWECKER & MATHIS, L.L.P. P.O. Box 1404 Alexandria, VA 22313-1404			EXAMINER BRIER, JEFFERY A	
			ART UNIT 2628	PAPER NUMBER
			MAIL DATE 10/09/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/934,479

Applicant(s)

FUJIWARA ET AL.

Examiner

Jeffery A. Brier

Art Unit

2628

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,11-15,17-34 and 42-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,11-15,17-34 and 42-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/25/2009 has been entered.

Response to Amendment

2. The amendment filed on 08/25/2009 has been entered. The claim amendments overcomes the issues set forth for the dependent claims in the office action mailed on 02/25/2009 but does not overcome the issues set forth for the independent claims for the reasons given below.

Response to Arguments

3. Applicant's arguments concerning the indefinite issue of the independent claims filed 08/25/2009 at page 16 second full paragraph does not satisfy MPEP 2173.03 and 2173.05(a)(I) at page 2100-220 Original Eighth Edition, August 2001 Latest Revision July 2008 because the claimed "means for detecting a user selection" of claims 1, 3, and 5, or "detect a user selection" step of claims 9,11, and 13 or "detecting a user selection" step of claim 17 or "a detection circuit for detecting a user selection" of claim 27, or a "circuit for: detecting a user selection" of claims 32 and 33 has several claim interpretations which does not allow one of ordinary skill in the art to be apprised of the

metes and bounds of the claim. Refer to the September 2, 2008 John Love memo regarding:

"Indefiniteness rejections under 35 U.S.C. 112, second paragraph" which states on page 2:

If the language of a claim, considered as a whole in light of the specification and given its broadest reasonable interpretation, is such that a person of ordinary skill in the relevant art would read it with more than one reasonable interpretation then a rejection of the claim under 35 U.S.C. 112, second paragraph, is appropriate.⁸ Where the claim is subject to more than one interpretation and at least one interpretation would render the claim unpatentable over the prior art, examiner should reject the claim as indefinite under 35 U.S.C. 112, second paragraph, and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable.⁹

⁸ MPEP 2173.05(a); *see also* MPEP 2143.03 subsection I and 2173.06

⁹ *Id.*

and may be viewable at:

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/section_112_2nd_09_02_2008.pdf

Refer to the September 2, 2008 John Love memo regarding:

"Rejections under 35 U.S.C. 112, second paragraph, when examining means (or step) plus function claim limitations under 35 U.S.C. 112, sixth paragraph" item III and may be viewable at:

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/section_112_6th_09_02_2008.pdf

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 17, 24-26, 30, and 44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Method claims 17, 24-26, 30, and 44:

Supreme Court precedent¹ and recent Federal Circuit decisions² indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

The August 24, 2009 interim patent subject matter eligibility examination instructions sets forth a 35 USC 101 analysis which analysis renders these claims patent ineligible because the method steps are not tied to a particular machine. The instructions may be viewed at: http://www.uspto.gov/web/offices/pac/dapp/opla/2009-08-25_interim_101_instructions.pdf.

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

These method claims do not tie the method to 1) a particular apparatus because the actor of these steps may be the human operator who performs the claimed abstract mathematical steps or 2) transform underlying subject matter because no physical transformation is claimed.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 3-9, 11-15, 17-34, and 42-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1, 3, 5, 9, 11, 13, 17, 27, 32, and 33:

The detecting portion of these claims may be interpreted to cover different steps of applicants specification and by drafting the claimed detecting to cover different steps the claims do not distinctly point out the invention. Independent claims 1, 3, and 5 claim "means for detecting a user selection", independent claims 9, 11, and 13 claim "detect a user selection" step, independent claim 17 claims a step of "detecting a user selection", independent claim 27 claims "a detection circuit for detecting a user selection", and independent claims 32 and 33 claim a "circuit for: detecting a user selection". The specification describes several different steps that perform the claimed function such as step 101, step 102, the step before step 101, and step 103. The specification at page 9 lines 3-11 describes step S101 as executing "pre-scan" and "main scan" which scans

the document which detects the mark placed on the document by the user. The specification at page 9 lines 12-19 describes step S102 "In step 102, a determination is made as to whether or not a mark has been detected in the pre-scan image data.". The specification at page 9 lines 19-23 describes a step before 101 "This mark is added to the document by the user beforehand using a marker such as a felt-tip pen or the like. The user marks at least an area containing a headline and body text corresponding to the headline.". The specification at page 9 line 24 to page 10 line 3 describes step S103 "In step S103, a screen inviting the user to attach a mark to the document is displayed on the touch panel display of the operation unit 140. In this case the user appends a mark on the document, and the document block extraction process is again executed." In view of MPEP 2173.03 and 2173.05(a)(I) at page 2100-220 Original Eighth Edition, August 2001 Latest Revision July 2008, the means or steps of the specification covered by the above quoted claim limitations is unclear due to the detecting of the claims covering more than one of the different steps described in the specification.

2173.03Inconsistency Between Claim *>and< Specification Disclosure or Prior Art [R-1] [R-1]

Although the terms of a claim may appear to be definite, inconsistency with the specification disclosure or prior art teachings may make an otherwise definite claim take on an unreasonable degree of uncertainty. *In re Cohn*, 438 F.2d 989, 169 USPQ 95 (CCPA 1971); *In re Hammack*, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970). In *Cohn*, the claim was directed to a process of treating a surface with a corroding solution until the metallic appearance is supplanted by an "opaque" appearance. Noting that no claim may be read apart from and independent of the supporting disclosure on which it is based, the court found that the description, definitions and examples set forth in the specification relating to the appearance of the surface after treatment were inherently inconsistent and rendered the claim indefinite.

2173.05(a)New Terminology [R-3]

I.THE MEANING OF EVERY TERM SHOULD BE APPARENT

The meaning of every term used in a claim should be apparent from the prior art or from the specification and drawings at the time the application is filed. Applicants need not confine themselves to the terminology used in the prior art, but are required to make clear and precise the terms that are used to define the invention whereby the metes and bounds of the claimed invention can be ascertained. During patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969). See also MPEP § 2111 - § 2111.01. When the specification states the meaning that a term in the claim is intended to have, the claim is examined using that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art. *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989).

Also Refer to the September 2, 2008 John Love memo "Indefiniteness rejections under 35 U.S.C. 112, second paragraph" discussed above in the response to arguments section of this office action.

The dependent claims of these claims do not correct this issue.

Independent claims 1, 3, 5, and 17:

Independent claims 1, 3, and 5 claim "means for detecting a user selection" and claim 17 claims a step of "detecting a user selection". Claim elements "means for detecting a user selection" and claim 17 claims a step of "detecting a user selection" is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to clearly link or associate the disclosed structure, material, or acts to the claimed function such that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function for the same reasons given above for this applications different steps that perform the claimed

function such as step 101, step 102, the step before step 101, and step 103. Refer to the September 2, 2008 John Love memo discussed above "Rejections under 35 U.S.C. 112, second paragraph, when examining means (or step) plus function claim limitations under 35 U.S.C. 112, sixth paragraph" item III" in the response to arguments section of this office action.

The dependent claims of these claims do not correct this issue.

Conclusion

8. Kurosawa teaches at column 1 lines 29-36 a step similar to applicants step S102 and S103 and Bloomberg teaches a step similar to applicants step S101.

9. An analysis of the claimed invention with regard to the prior art will be held in abeyance until the claimed invention has been clarified since the metes and bounds of the claims are not definite. Thus, a prior art rejection or an indication of allowability cannot be made with the currently pending claims. In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A. Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:30 to 4:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xiao Wu

can be reached at (571) 272-7661. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffery A. Brier/
Primary Examiner, Art Unit 2628